REMARKS

Claims 70 and 98-105 are pending. By this amendment, Applicants have amended claims 70 and 105 to correct a minor typographical error in punctuation. No new matter has been added. Applicants respectfully request entry of the amendment and allowance of the pending claims.

Rejections Under 35 U.S.C. § 102(b)

The Examiner rejected claims 70 and 98-105 as allegedly anticipated by U.S. 5,366,860 to Bergot *et al.* (Bergot). The Examiner alleged that Bergot discloses rhodamine dyes in formulas I-IV in columns 3 and 4, and that XTP in Bergot corresponds to NUC of the present claims, L in Bergot corresponds to L' of the present claims, and that carboxy substituted R in Bergot corresponds to a structure of present claim 70.

Applicants respectfully disagree with the Examiner, and submit that the Examiner has failed to establish a *prima facie* case for anticipation based on the Bergot reference. To establish a *prima facie* case for anticipation, the Examiner must show that a single reference discloses each and every element of the claim.[1] Applicants submit that the Examiner has failed to show where the Bergot reference discloses a rhodamine-type parent xanthene having attached to the xanthene C9 carbon a phenyl group that is further substituted with one to three aminopyridinium groups. Applicants submit that the Examiner cannot establish a *prima facie* case for anticipation using the Bergot reference, because the Bergot reference does not disclose a rhodamine-type parent xanthene having attached to the xanthene C9 carbon a phenyl group that is further substituted with one to three substituted aminopyridinium groups. Thus, the Bergot reference does not disclose each and every element of the rejected claims. Accordingly, Applicants request reconsideration and withdrawal of the rejections based on the Bergot reference.

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[1] See, for example, *W.L Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Rejections Under 35 U.S.C. § 102(e)

The Examiner rejected claims 70 and 98-105 as allegedly anticipated by U.S. Patent No. 5,847,162 to Lee *et al.* (Lee '162). The Examiner alleged that Lee '162, at column 4, discloses a labeled nucleotide that reads on the rejected claims.

Applicants respectfully disagree with the Examiner, and submit that the Examiner has failed to establish a *prima facie* case for anticipation based on the Lee '162 reference. The Examiner has not shown where the Lee '162 reference discloses a rhodamine-type parent xanthene having attached to the xanthene C9 carbon a phenyl group that is further substituted with one to three aminopyridinium groups. Applicants submit that the Examiner cannot establish a *prima facie* case for anticipation using the Lee '162 reference, because the Lee '162 reference does not disclose a rhodamine-type parent xanthene having attached to the xanthene C9 carbon a phenyl group that is further substituted with one to three aminopyridinium groups. Thus, the Lee '162 reference does not disclose each and every element of the rejected claims. Accordingly, Applicants request reconsideration and withdrawal of the rejections based on the Lee '162 reference.

Double Patenting Rejections

The Examiner rejected claims 70 and 98-105 under the judicially created doctrine of obviousness-type double patenting over claims 1-9 of U.S. Patent No. 6,017,712 (the '712 Patent), alleging that a labeled nucleotide in the '712 Patent is embraced by the rejected claims. The Examiner alleged that the linking group L of the rejected claims embraces a linkage disclosed in claim 1 of the '712 Patent.

The Examiner rejected claims 70 and 98-105 under the judicially created doctrine of obviousness-type double patenting over claims 24-36 of U.S. Patent No. 6,080,852 (the '852 Patent), alleging that a labeled nucleotide in the '852 Patent is embraced by the rejected claims. The Examiner alleged that a linking group L of the rejected claims embraces a linking group in claims 26-31 of the '852 Patent.

Applicants respectfully disagree with the Examiner and submit that the Examiner has failed to state a *prima facie* case for obviousness-type double patenting. To establish

a *prima facie* case for obviousness-type double patenting, an Examiner must show that the claimed inventions are not patentably distinct, based on a *prima facie* showing of obviousness,[2] and present clear evidence as to why an alleged variation of an invention claimed in a prior patent would have been obvious.[3] Applicants submit that the Examiner has not presented any evidence why, for example, the '712 Patent or the '852 Patent renders obvious a claim that recites a rhodamine-type parent xanthene having attached to the xanthene C9 carbon a phenyl group that is further substituted with one to three aminopyridinium groups. Accordingly, Applicants request reconsideration and withdrawal of the double-patenting rejections based on the '712 Patent and the '852 Patent.

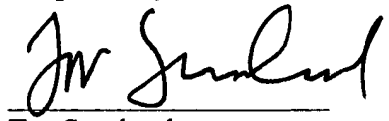
Conclusion

In view of the foregoing amendments, and the remarks set forth above, reconsideration and allowance are respectfully requested.

Enclosed is the fee for a one-month extension of time. No additional fee is believed to be due with respect to the filing of this amendment. If any additional fees are due, or an overpayment has been made, please charge, or credit, our Deposit Account No. 11-0171 for such sum.

If the Examiner has any questions regarding the present application, the Examiner is cordially invited to contact Applicant's attorney at the telephone number provided below.

Respectfully submitted,



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[2] See, for example, *In re Longi*, 759 F2d 887 (Fed. Cir. 1985).
[3] *In re Kaplan*, 789 F.2d 1574 (Fed. Cir. 1986).